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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,343	04/17/2006	Alan Haaksma	8506-60087	2706
35973 7590 04/13/2009 BINGHAM MCHALE LLP 2700 MARKET TOWER 10 WEST MARKET STREET INDIANAPOLIS, IN 46204-4900				
EXAMINER				
REYES, REGINALD R				
ART UNIT		PAPER NUMBER		
3626				
NOTIFICATION DATE		DELIVERY MODE		
04/13/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/542,343

Applicant(s)

HAAKSMA ET AL.

Examiner

REGINALD REYES

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 23-25, 29-31, 44-45, 49-50, 52-53, and 58-64 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Claims 1, 23-25, 29-31, 44-45, 49-50, 52-53, and 58-64 have been examined.

Response to Arguments

2. The affidavit filed on 2-13-2009 under 37 CFR 1.131 has been considered but is ineffective to overcome the Tangellapally reference. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Provisional application 3-21-2000 reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The attachments of the affidavit are missing.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "approximately" in claim 31 is a relative term which renders the claim indefinite. The term "approximately" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

4. Claim 61 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 61 recites the limitation "the record access certificate" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 23-25, 29, 44-45, 49, 58-64 are rejected under 35 U.S.C. 102 (b) as being anticipated by Tangellapally et al (U.S. 7,426,475).

7. With respect to claims 1, 44 and 58, Tangellapally teaches a method of creating a conveniently accessible medical history for a patient, said method comprising the

steps of: 1) establishing an information-transmission connection with a remote information-input node (see for example Tangellapally column 4 lines 55-64 and column 9 lines 55-67 and column 10 lines 1-13); 2) receiving medical information through said information-transmission connection from said information-input node (see for example Tangellapally column 10 lines 51-55); 3) configuring said information into a medical history record (see for example Tangellapally column 8 lines 64-67 and column 9 line 1-4); and 4) transmitting said medical history record to a remote record output node which record output node is configured to receive said medical history record; whereby a conveniently accessible medical history can be created at one location and accessed via a remote record output node (see for example Tangellapally column 4 lines 18-23).

8. With respect to claim 23, Tangellapally teaches a method of creating a conveniently accessible medical history for a patient, said method comprising the steps of: 1) establishing an information-transmission connection with a remote record-creating node (see for example Tangellapally column 4 lines 55-64 and column 9 lines 55-67 and column 10 lines 1-13; 2) transmitting medical information through said information-transmission connection to said record-creating node, said record-creating node being adapted to configure said information into a medical history record and to transmit said medical history record to a remote record output node (see for example Tangellapally column 10 lines 51-55 and column 4 lines 18-23).

9. With respect to claim 24, Tangellapally teaches the method of claim 23 (as described above). Tangellapally teaches further comprising the step of receiving said medical history record from said record-creating node at said record output node (see for example Tangellapally column 10 lines 51-55).

10. With respect to claims 25, 45 and 59, Tangellapally teaches the method of claim 24 (as described above). Tangellapally teaches, wherein said step 2 comprises the step of transmitting to said record creating node, said record creating node being adapted to configure said information into a medical history record that is storable on a portable readable storage medium, the method further comprising the step of storing said medical history record on said portable readable storage medium (see for example Tangellapally column 4 lines 18-23).

11. With respect to claim 29 and 49, Tangellapally teaches the method of claim 25 (as described above). Tangellapally teaches further comprising the step of inspecting said medical history record prior to the storing step (see for example Tangellapally column 15 lines 4-12).

12. With respect to claim 52, Tangellapally teaches the system of claim 44 (as described above). Tangellapally teaches said information-input node comprising a computer (see for example Tangellapally column 4 lines 55-63).

13. With respect to claim 60, Tangellapally teaches the method of claim 59 (as described above). Tangellapally teaches further comprising prior to the step of saving said medical history record, the step of transmitting said medical history record to a remote record output node (see for example Tangellapally column 3 lines 17-22 and column 4 lines 18-23).

14. With respect to claim 61, Tangellapally teaches the method of claim 58 (as described above). Tangellapally teaches further comprising, prior to the step of saving the record access certificate, the step of transmitting the record access certificate to the remote record output node (see for example Tangellapally column 4 lines 47-54).

15. With respect to claim 62, Tangellapally teaches the method of claim 58 (as described above). Tangellapally teaches said step 4 comprising the step of saving, on said portable readable storage medium, a PKI certificate of said patient, for granting access to said medical history record (see for example Tangellapally column 10 lines 66-67 and column 11 lines 1-17 and column 3 lines 17-22 and column 4 lines 18-23).

16. With respect to claim 63 Tangellapally teaches the method of claim 58 (as described above). Tangellapally teaches wherein said configuring step further includes including in said medical history record medical condition information relating to a medical condition of the patient, the medical condition information including information

on symptoms and treatment of the medical condition (see for example column 14 lines 30-42).

17. With respect to claim 64 Tangellapally teaches a method of accessing the medical history record of a patient, the method comprising: 1) reading a record access certificate from a portable readable storage medium (see for example Tangellapally column 4 lines 55-64 and column 9 lines 55-67 and column 10 lines 1-13); 2) attempting to establish a connection with a remote node holding a primary medical history record (see for example Tangellapally column 10 lines 51-55 and column 4 lines 18-23). Additionally in regards to claim 64, the Examiner further notes the recited "if" do not move to distinguish the claimed invention from the cited art. These phrases are conditional limitations with the noted "if" step not necessarily performed. Accordingly, once the positively recited steps are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios. [See: In re Johnston, 77 USPQ2d 1788 (CA FC 2006); Intel Corp. v. Int'l Trade Comm'n, 20 USPQ2d 1161 (Fed. Cir. 1991); MPEP §2106 II C].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 30-31, 50 and 31 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Tangellapally et al (U.S. 7,426,475).

19. With respect to claims 30-31, 50 and 31 Tangellapally teaches the method of claim 25 (as described above). Tangellapally does not teach the storing step comprising storing the medical history record on a compact disk. However Official Notice is taken that the history of storage devices includes compact discs, smart cards, flash drive, etc... Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Tangellapally with the commonly recognized practice of storing data. The motivation would have been to make stored data more accessible.

20. Claim 53 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Tangellapally et al (U.S. 7,426,475) in view of Grushka (U.S. 7,395,215)

With respect to claim 53, Tangellapally teaches the system of claim 52 (as described above). Tangellapally does not teach said information input node further comprising a fax machine, said information-transmission connection further comprising a connection between said fax machine and said record-creating node. Grushka teaches said information input node further comprising a fax machine, said information-transmission connection further comprising a connection between said fax machine and said record-creating node (see for example Grushka column 8 lines 7-14). One of ordinary in the art at the time of invention was made would have found it obvious to include a fax

machine as taught in Grushka with the medical history system as taught in Tangellapally with the motivation of providing a system that is capable of communicating with the available communication systems to provide better service to the clients.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 5,832,488 teaches computer system and method for storing medical histories using a smartcard to store data.

U.S. Patent No. 6,154,726 teaches system and method for recording patient history data about on-going physician care procedures.

U.S. Patent No. 5,911,687 teaches wide area medical information system and method using thereof.

U.S. Patent No. 5,899,998 teaches method and system for maintaining and updating computerized medical records.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to REGINALD REYES whose telephone number is (571)270-5212. The examiner can normally be reached on 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Gilligan can be reached on 571-272-6670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. R./
Examiner, Art Unit 3626

/C. Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626